

DETAILED ACTION

Claim Objections

1. Claims 23, 25 and 28-30 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 2, 4 and 8-10 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 8, 11, 16-18, 20-26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Hendricks et al. (U.S. Patent No. 6,463,585).

Regarding claim 1, Hendricks discloses a method of using a trigger in a video stream to access preferred information for displaying targeted information with a video signal comprising: obtaining said preferred information (see [column 4 lines 12-16], [column 5 lines 7-11], [column 58 lines 10-16], [column 66 lines 37-40] for using demographic information and preference information such as

viewing habits); obtaining a list of addresses of said targeted information (see [column 31 lines 28-41], [column 31 lines 43-46], [column 72 lines 53-63] where a list of advertisement/promotional material is obtained; see also [column 33 lines 37-40] where the advertisements are linked by address for future retrieval); receiving said trigger (see [column 4 lines 43-53], [column 6 lines 1-22] for receiving a switching plan which contains multiple triggers); selecting an address from said list of addresses of said targeted information based upon said trigger and said preferred information (see [column 31 lines 28-53], [column 33 lines 37-40], [column 58 lines 10-23], [column 66 lines 37-40], [column 68 lines 48-53] where user information and designations made by the switching plan are used to determine which addressed commercial will be selected); obtaining said targeted information using said address (see [column 33 lines 37-42] where the targeted information is retrieved using an address referred to herein as a storage location); combining said targeted information with said video signal for display (see [column 5 lines 56-67], [column 7 lines 2-5] where default targeted information is embedded into the program stream, [column 33 lines 24-29], [column 33 lines 37-42], [column 61 lines 38-42], [column 72 lines 53-57] for targeted information which is combined with the primary program signal).

Regarding claims 2 and 23, Hendricks discloses storing said preferred information at a viewer location (see [column 6 lines 23-37], [column 66 lines 37-40] for storing viewer information locally).

Regarding claim 3, Hendricks discloses storing said list of addresses of said targeted information at said viewer location (see [column 34 lines 63-68], [column 33 lines 37-40] for target information which is stored within the memory of the set top terminal and its retrieval by means of a local storage location or address for future airing).

Regarding claims 4 and 25, Hendricks discloses storing said preferred information at an upstream source (see [column 18 lines 12-15], [column 33 lines 31-32], [column 41 lines 12-18], [column 42 lines 65-66], [column 44 lines 8-30], [column 58 lines 10-16] for viewer data stored at an upstream source).

Regarding claim 5, Hendricks discloses storing said list of addresses of said targeted information at said upstream source (see [column 31 lines 28-41], [column 31 lines 43-46], [column 72 lines 53-63] where a list of advertisement/promotional material is obtained; see also [column 33 lines 37-40] where the advertisements are linked by address for future retrieval; see also [item 307 in figure 4c] where the spot placement engine is an upstream source).

Regarding claims 8 and 28, Hendricks discloses all of the limitations of claim 1 including wherein said step of combining further comprises: generating a targeted video signal from said targeted information (see [column 33 lines 38-40] where target information is maintained; see also [column 33 lines 24-29], [column 61 lines 38-42], [column 72 lines 53-57] where a targeted video signal is generated from targeted information (location data) and inserted on a feeder channel); and combining said targeted video signal with said video signal to

generate a combined video signal (see [column 5 lines 56-67], [column 7 lines 2-5] where default targeted information is embedded into the program stream, [column 33 lines 24-29], [column 33 lines 37-42], [column 61 lines 38-42], [column 72 lines 53-57] for targeted information which is combined with the primary program signal).

Regarding claim 11, Hendricks discloses a method of using a trigger from a group of multiple triggers that are associated with a video signal to access preferred information for display of targeted information with a video signal comprising: obtaining said preferred information (see [column 4 lines 12-16], [column 5 lines 7-11], [column 58 lines 10-16], [column 66 lines 37-40] for using demographic information and preference information such as viewing habits); obtaining a list of addresses of said targeted information (see [column 31 lines 28-41], [column 31 lines 43-46], [column 72 lines 53-63] where a list of advertisement/promotional material is obtained; see also [column 33 lines 37-40] where the advertisements are linked by address for future retrieval); receiving said multiple triggers (see [Table D and Table F] where multiple triggers are embedded in the switching plan; see also [column 4 lines 43-53], [column 6 lines 1-22] for receiving a switching plan which contains multiple triggers); selecting an address from said list of addresses by comparing said multiple triggers with said preferred information (see [Table D and Table F] where multiple triggers are embedded in the switching plan; see also [column 31 lines 28-53], [column 33 lines 37-40], [column 58 lines 10-23], [column 66 lines 37-40], [column 68 lines

48-53] where user information and designations made by the switching plan are used to determine which addressed commercial will be selected); obtaining said targeted information using said address (see [column 33 lines 37-42] where the targeted information is retrieved using an address referred to herein as a storage location); combining said targeted information with said video signal for display (see [column 5 lines 56-67], [column 7 lines 2-5] where default targeted information is embedded into the program stream, [column 33 lines 24-29], [column 33 lines 37-42], [column 61 lines 38-42], [column 72 lines 53-57] for targeted information which is combined with the primary program signal).

Regarding claim 16, Hendricks discloses all of the limitation of claim 11, further comprising: storing said preferred information (see [column 6 lines 23-37], [column 66 lines 37-40] for storing viewer information locally; see also [column 18 lines 12-15], [column 33 lines 31-32], [column 41 lines 12-18], [column 42 lines 65-66], [column 44 lines 8-30], [column 58 lines 10-16] for viewer data stored at an upstream source).

Regarding claim 17, Hendricks discloses a system for displaying targeted information with a video stream comprising: a trigger embedded in said video stream (see [column 6 lines 7-20], [column 28 lines 2-8], [column 33 lines 19-23], [column 33 lines 44-46], [column 77 line 5], [column 78 line 4] for embedding the switching plan which contains triggers in the video stream); a decoder that separates said trigger from said video stream (see [column 28 line 9-10], [column 33 lines 65-66] where the trigger carrying package is decoded from the program

signal); preferred information storage that stores preferred information (see [column 4 lines 2-5] for the television terminals used as the preferred storage of preferred information in the form of targeted advertisements; see also [column 20 lines 4-35], [column 21 lines 8-11] for the use of the set top terminal as the preferred storage where preferred information is stored; see also [column 59 lines 52-58] for a local storage or memory device being used as a preferred storage location for preferred information in the form of the subscriber's program access history or preferred programs as indicated by their access history); address storage that stores a plurality of addresses of said targeted information (see [column 31 lines 28-41], [column 31 lines 43-46], [column 72 lines 53-63] where a form of address storage or list maintains the information necessary (location) to select and air targeted information in the form of advertisement/promotional material from a predefined location; see also [column 33 lines 37-40] where the advertisements are linked to a particular location in storage also known as a storage address); a processor that selects at least one address from said plurality of addresses based upon said trigger and said preferred information and obtains said targeted information using said address (see [column 31 lines 28-53], [column 33 lines 37-40] for the selection of a particular address containing a particular advertisement; see also [column 58 lines 10-23], [column 66 lines 37-40], [column 68 lines 48-53] where user information and designations made by the trigger containing switching plan determines which addressed commercial will be selected; see also [column 33 lines 37-42] where the targeted

information is retrieved using an particular location also referred to as a storage address or storage location; see also [figures 33 and 34], [column 61 lines 30-34] it is well know that some form of processing mechanism would be used to accomplish the task listed above); a combiner that combines said targeted information with said video signal for display (see [column 5 lines 56-67] for a combiner referred to as a spot placement engine which embeds default targeted information in the form of an advertisement in the video signal or program stream; see also [column 7 lines 2-5] where default targeted information is placed or embedded into the program stream, [column 33 lines 24-29], [column 33 lines 37-42], [column 61 lines 38-42], [column 72 lines 53-57] for targeted information which is combined with the primary program signal by means of a combiner referred to herein as an insertion component).

Regarding claim 18, Hendricks discloses a video combiner that combines video signals to generate a combined video signal (see [column 5 lines 56-67] for a targeted video advertisement which is combined with the program stream; see also [column 7 lines 2-5] where a default targeted advertisement video is placed or embedded into the program stream, [column 33 lines 24-29], [column 33 lines 37-42], [column 61 lines 38-42], [column 72 lines 53-57] for a targeted advertisement which is combined with the primary program signal by means of a combiner referred to herein as an insertion component. The advertisement mentioned is equivalent to a video signal).

Regarding claim 20, Hendricks discloses wherein said decoder, said preferred information storage, said address storage, said processor and said combiner are all located at a viewer's location (for a decoder see [column 6 lines 11-13], [column 15 lines 17-23], [column 28 line 9-10], [column 33 lines 65-66] for a device at the viewer's location capable of decoding; for a preferred information storage see [column 4 lines 2-5] for the television terminals used as the preferred storage of preferred information in the form of targeted advertisements; see also [column 20 lines 4-35], [column 21 lines 8-11] for the use of the set top terminal as the preferred storage where preferred information is stored; for address storage see [column 34 lines 63-68], [column 33 lines 37-40] for target information which is stored within the memory of the set top terminal and its retrieval by means of a local storage location or address for future airing; for a processor see [figures 33-35 item 602], [column 61 lines 30-34] for a processing device; furthermore it is well known in the art that some form of processing mechanism would necessarily be included in a set top terminal to accomplish the procedures described; for a combiner see [figure 34 item 604], [figure 35 item 316] for a device which combines at the viewers location; furthermore it is well known in the art that some form of combining device would be used and necessary for the display of the advertisement within the program stream).

Regarding claim 21, Hendricks discloses wherein said decoder, said preferred information storage, said address storage, said processor and said combiner are all located at an upstream source (for a decoder see [column 33

lines 44-46], [column 33 lines 57-61], [column 61 lines 20-34], [column 61 lines 57-67] where decoding device is located at the headend and separates trigger information from the video/audio stream; for a preferred information storage see [figure 23 and 24 item 314], [column 66 lines 30-35], [column 66 lines 37-51] for preferred information obtained from profile information stored in the network control database, [column 44 lines 12-18] preferred information on the marketing and customer information database; for address storage see [column 31 lines 28-32], [column 33 lines 37-40] for a list of targeted information which maintains the locations of said information in storage in the operations center; for a processor see [column 5 lines 52-60], [column 27 lines 39-50], [column 31 lines 28-32], [figure 4 item 264] for a processor at the operations center; for a combiner see [column 53 line 54 - column 54 line 3].

Regarding claim 22, Hendricks discloses a method of using triggers in a video stream to access preferred information for displaying targeted information with a video signal comprising : obtaining said preferred information; receiving said triggers (see [column 4 lines 43-53], [column 6 lines 1-22] for receiving a switching plan which contains multiple triggers; see also [Table D and Table F] where multiple triggers are embedded in the switching plan); comparing said triggers to said preferred information (see [Table D and Table F] where multiple triggers are embedded in the switching plan; see also [column 31 lines 28-53], [column 33 lines 37-40], [column 58 lines 10-23], [column 66 lines 37-40], [column 68 lines 48-53] where user information (preferred information) and

designations made by the switching plan are used to determine which addressed commercial will be selected based upon matching or targeting); selecting addresses from said triggers that correspond to said preferred information (see [column 31 lines 28-53], [column 33 lines 37-40], [column 58 lines 10-23], [column 66 lines 37-40], [column 68 lines 48-53] where user information and designations made by the switching plan determine which addressed commercial will be selected to properly target the information); obtaining said targeted information using said addresses (see [column 33 lines 37-42] where the targeted information is retrieved using an address referred to herein as a storage location); combining said targeted information with said video signal for display (see [column 5 lines 56-67], [column 7 lines 2-5] where default targeted information is embedded into the program stream, [column 33 lines 24-29], [column 33 lines 37-42], [column 61 lines 38-42], [column 72 lines 53-57] for targeted information which is combined with the primary program signal).

Regarding claim 24, Hendricks discloses all of the limitations of claim 2 including storing said targeted information at said viewer location (see [column 34 lines 62-67], [column 72 lines 64-67] for storing targeted information such as commercials at the set top terminal).

Regarding claim 26, Hendricks discloses the method of claim 4 further comprising storing said targeted information at said upstream source (see [figure 4 item 267], [figure 11 item 266], [column 42 lines 24-26], [column 48 lines 54-63]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 6, 7, 12, 13 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. in view of Dudkiewicz et al. (U.S. Patent No. 6,973,665 B2).

Regarding claims 6 and 12, Hendricks does not explicitly teach storing said list of addresses by category and identification information; storing said preferred information by category information; determining category and identification information of said trigger.

Dudkiewicz teaches storing list of addresses by category and other identifying information (see [column 19 lines 11-21] where an information alert

list a schedule of programming events including an indication of categories or keywords matched and the channel number or identifier required to view the program); storing preference information by category information (see [abstract], [column 23 lines 1-4], [column 23 line 66 through column 24 line 5], [column 24 lines 53-57]); determining category and other identifying information of trigger information (see [column 29 lines 31-40], [column 31 lines 10-17] for identifying the categories of upcoming program triggers).

At the time the invention was made it would have been obvious, to one of ordinary skill in the art, to use category, keyword, and identification information, as taught in Dudkiewicz, to target advertisements to users by means of video, as taught in Hendricks, because the use of categories and other identifying information more accurately represents the monitored viewing habits and preferences of the user which can include programming events involving other types of media such as advertisements (see [column 3 lines 34-44], [column 3 lines 51-53], [column 31 lines 10-17]).

Regarding claims 7 and 13, Hendricks does not explicitly teach selecting said address of said targeted information using said category information of said preferred information, and said category and identification information of said list of addresses and said trigger.

Dudkiewicz teaches selecting an address, by recommending for transmission or automatically transmitting, using category information and other identifying information from a schedule of programming events based on

information derived from the program trigger category and other identifying information embedded into the program data (see [column 1 lines 36-38], [column 4 lines 9-16], [column 19 lines 11-21], [column 29 lines 33-40], [column 31 lines 10-17]).

At the time the invention was made it would have been obvious, to one of ordinary skill in the art, to use category, keyword, and identification information, as taught in Dudkiewicz, to target advertisements to users by means of video, as taught in Hendricks, because the use of categories and other identifying information more accurately represents the monitored viewing habits and preferences of the user which can include programming events involving other types of media such as advertisements (see [column 3 lines 34-44], [column 3 lines 51-53], [column 31 lines 10-17]).

Regarding claim 27, Hendricks does not disclose: classifying said preferred information and triggers by key words; selecting addresses from said triggers by comparing key words of said preferred information and said triggers.

Dudkiewicz teaches classifying preferred information and triggers by keywords (see [abstract], [column 3 lines 34-44], [column 4 lines 5-16]); and selecting by recommending for transmission or automatically transmitting program events listed with addresses in the form of a channel number or identifier, by comparing for the purpose of matching keywords of preferred information and triggers embedded in the program events (see [column 19 lines

11-21], [column 23 lines 1-17], [column 23 line 63 through column 24 line 5], [column 29 lines 33-40]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to use keywords as a means of selecting matching criteria, as taught in Dudkiewicz, to target advertisements by means of video, as taught in Hendricks, because the use of keywords, when facilitated by pre-existing categories, would simplify achieving the objective of targeting advertising by providing the categories as a basis for a keyword search (see [column 1 lines 36-38], [column 3 lines 34-44], [column 4 lines 5-16]).

4. Claims 9, 10, 15, 19 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. in view of Broadwin et al. (U.S. Patent No. 5,929,850).

Regarding claims 9, 15 and 29 Hendricks does not explicitly teach wherein said step of combining further comprises generating an interactive page from said targeted information.

Broadwin teaches generating interactive pages for use on a television display (see [column 3 lines 24-27], [column 4 lines 1-5], [column 5 lines 21-23]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the interactivity of web like functionality, as taught in Broadwin, with targeted advertising, as taught in Hendricks, because by adding the interactivity users may view and make selections to purchase

products or receive additional information thereby enhancing the effectiveness of advertisement targeting (see [column 1 line 59 through column 2 line 8]).

Regarding claims 10 and 30, Hendricks does not explicitly teach wherein said step of combining, as stated in claim 9 and 29, further comprises combining said interactive page with said video signal.

Broadwin teaches combining said interactive page with said video signal (see [column 5 lines 21-33]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the interactivity of web like functionality, as taught in Broadwin, with targeted advertising, as taught in Hendricks, because by adding the interactivity users may view and make selections to purchase products or receive additional information thereby enhancing the effectiveness of advertisement targeting (see [column 1 line 59 through column 2 line 8]).

Regarding claim 19, Hendricks discloses providing access to websites via the internet but does not explicitly teach combining the websites (HTML pages) with a video signal.

Broadwin teaches a combiner that combines internet pages with a video signal (see [abstract], [column 1 lines 13-16], [column 18 lines 48-51], [column 6 lines 18-23], [column 15 lines 21-25]).

At the time the invention was made it would have been obvious, to one of ordinary skill in the art, to combine the HTML pages with a video signal, as taught in Broadwin, to enhance the selection targeted commercials, as taught in

Hendricks, because by allowing the integration of the HTML pages from the internet would improve the interactivity of the television system and provide on-demand web-like capabilities for displaying requested media (see [column 2 lines 16-22]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON THOMAS whose telephone number is (571)270-5080. The examiner can normally be reached on Mon. - Thurs., 8:00a.m. - 5:00p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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